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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,587	12/18/2001	Kurt C. Melancon	55468US002	1248

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16
EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,587

Applicant(s)

MELANCON ET AL.

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-23 and 25-63 is/are rejected.
- 7) ☒ Claim(s) 3-7, 25, 26, 35, 36, 42, 43 and 49-51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Discussion of "X" References

These references were cited as "X" references on an International Search Report from a foreign counterpart application and submitted by applicant for review: EP 0667382A, WO 9740103, WO 9634028, and WO 9635458. WO 9634028 was applied in the previous office action and as set forth below. WO 9740103 and WO 9635458 appear to contain essentially the same content as WO 9634028, and were therefore not applied. EP 0667382A also appears to contain essentially the same content as WO 9634028, and was not applied.

Claim Rejections - 35 USC § 112

The rejection of claim 30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to applicant's arguments.

Claim Rejections - 35 USC § 103

The rejection of claims 1, 8-24, 27-34, 37-41, 44-48, and 52-63 under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028) in view of Flannigan

(3,772,247) has been withdrawn in light of a new rejection; therefore, applicant's arguments in regards thereto are moot.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-23, and 25-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Sherman et al. (WO 96/34028). Regarding claims 1, 15, 16, Sherman et al. disclose a pressure sensitive adhesive (psa) comprising a tackifying silicone resin (page 8, lines 20-29 and page 19, line 5-page 10, line 13) and a polydiorganosiloxane polyurea copolymer (page 10, line 9-page 13, line 7). It is the examiner's position that the claim language "having no greater than" in claim 1 includes zero. It appears Sherman et al. do not necessarily contain Si-OH functional groups.

Regarding claim 2, although Sherman et al. do not appear to specifically disclose a high or low energy surface material. Sherman et al. disclose applying the psa composition to a variety of substrates (page 5, lines 19-29). As Applicant appears to be claiming any substrate by the claim language "wherein the psa adheres to both high and low surface energy materials as well as those in between," this appears to be included by Sherman et al.

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Regarding claim 8, Sherman et al. disclose wherein the polydiorganosiloxane polyurea copolymer is the reaction product of a polydiorganosiloxane polyamine with a polyisocyanate (page 14, line 4-page 16, line 30).

Regarding claim 10, Sherman et al. disclose the instantly claimed repeating unit (page 10, line 9-page 13, line 3).

Regarding claim 11, Sherman et al. disclose the instantly claimed limitation (page 11, lines 6-10).

Regarding claim 12, Sherman et al. disclose wherein m is a number included in the instantly claimed range (page 12, bottom of the page).

Regarding claim 13, Sherman et al. disclose a n number that is included in the instantly claimed range (page 10, line 3).

Regarding claim 14, Sherman et al. disclose a p number that is included in the instantly claimed range (page 13, line 1).

Regarding claim 17, Sherman et al. disclose wherein the silicone tackifying resin is present in an amount included in the instantly claimed range (page 20, lines 14-21).

Regarding claim 18, Sherman et al. disclose a ratio as instantly claimed (page 19, line 17, as disclosed in 5,248,739).

Regarding claim 19, Sherman et al. disclose a molecular weight as instantly claimed (page 19, lines 5-13).

Regarding claim 20, Sherman et al. disclose a plasticizer can be added (page 9, lines 21-23).

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Regarding claim 21, Sherman et al. disclose a solvent based composition (page 9, lines 24-27).

Regarding claim 22, the same reasoning as set forth above for claims 1 and 2 also applies to claim 22, as the claimed subject matter is essentially the same.

Regarding claim 23, the same reasoning as set forth above for claims 2 and 18 also applies to claim 23, as the claimed subject matter is essentially the same.

Regarding claim 27, the same reasoning as set forth above for claim 20 also applies to claim 27, as the claimed subject matter is essentially the same.

Regarding claim 28, the same reasoning as set forth above for claims 1, 11, and 12-14 also applies to claim 28, as the claimed subject matter is essentially the same.

Regarding claim 29, the same reasoning as set forth above for claim 1 also applies to claim 29, as the claimed subject matter is essentially the same, except for the limitation of a processing aid. Sherman et al. disclose a processing aid (page 9, lines 21-23) and an organic solvent (page 24, lines 21-27).

Regarding claim 30, Sherman et al. disclose a mixture of solvents (page 24, lines 16-24). It is the examiner's position that when in a mixture, one of the solvents can be considered a transient processing aid.

Regarding claims 31-33, Sherman et al. disclose the psa of claim 1 and the instantly claimed limitations (page 30, line 26-page 31, line 30).

Regarding claim 34, Sherman et al. disclose a primer layer (page 29, lines 21-27).

Regarding claim 37, Sherman et al. disclose a backing comprising acid functional groups (page 31, lines 15-18).

Regarding claims 38-40, the same reasoning as set forth above for claims 31-33 also applies to claims 38-40, as the claimed subject matter is essentially the same.

Regarding claim 41, Sherman et al. disclose a primer layer (page 29, lines 21-27).

Regarding claim 44, Sherman et al. disclose a backing comprising acid functional groups (page 31, lines 15-18).

Regarding claims 45-47, the same reasoning as set forth above for claims 31-33 also applies to claims 45-47, as the claimed subject matter is essentially the same.

Regarding claim 48, Sherman et al. disclose a primer layer (page 29, lines 21-27).

Regarding claims 52, 54, and 56, Sherman et al. disclose an article with the adhesive of claim 1 disposed therebetween (page 28, lines 4-13).

Regarding claims 53, 55, and 57, Sherman et al. disclose a vibration damper (page 28, lines 4-13).

Regarding claim 58, the same reasoning as set forth in claim 1 also applies to claim 58, as the claimed subject matter is essentially the same.

Regarding claim 59, the same reasoning as set forth above for claim 9 also applies to claim 59, as the claimed subject matter is essentially the same.

Regarding claim 60, the same reasoning as set forth in claim 10 also applies to claim 60, as the claimed subject matter is essentially the same.

Regarding claims 61-63, the same reasoning as set forth above for claims 15, 17, and 18 also applies to claims 61-63, respectively, as the claimed subject matter is essentially the same.

Claim Rejections - 35 USC § 102/103

Claim 24 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sherman et al. (WO 96/34028). Sherman et al. as applied above, are as set forth and incorporated herein. Sherman et al. do not appear to specifically disclose the instantly claimed property. However, it appears that this is inherently disclosed in Sherman et al. because the materials of Sherman et al. are the same as those claimed by applicant, and the same materials would have yielded a product with the same inherent properties, such as the instantly claimed adhesion. If not inherent, then it would have been obvious to one of ordinary skill in the art at the time the invention was made to have achieved an at least similar adhesion to that as claimed because the materials of Sherman et al. are at least similar to those of applicant's, and at least similar materials would have yielded a product with a least similar inherent properties, such as the instantly claimed adhesion.

Claim Rejections - 35 USC § 103

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028). Sherman et al., as applied above, are as set forth and

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incorporated herein. Sherman et al. do not appear to specifically disclose a chain extender. However, it is the Examiner's position that chain extenders are commonly used in the art to control the molecular weight of a polymer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a chain extender to control the molecular weight of the polymer.

Allowable Subject Matter

As indicated in the previous office action, claims 3-7, 25, 26, 35, 36, 42, 43, and 49-51, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding claims 3-7, 25, and 26, Sherman et al. disclose similar tests as those set forth, but the values achieved by Sherman et al. are significantly different than Applicant's. Regarding claims 35, 36, 42, 43, and 49-51, Sherman et al. do not teach or disclose a primer layer of the instantly claimed composition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan *CK*

July 11, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700